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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,117	11/27/2001	David Sonnenberg	5810.02	1589

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DORSEY & WHITNEY, LLP
INTELLECTUAL PROPERTY DEPARTMENT
370 SEVENTEENTH STREET
SUITE 4700
DENVER, CO 80202-5647

EXAMINER

NERBUN, PETER P

ART UNIT	PAPER NUMBER
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3765

DATE MAILED: 02/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/996,117

Applicant(s)

SONNENBERG ET AL.

Examiner

Peter P Nerbun

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-- Th MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-18,23-31,35-42,50-57,63-70,80-82,87-89 and 94-107 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5-18,23-31,35-42,50-57,63-70,80-82,87-89,94-100 and 105-107 is/are allowed.
- 6) ☒ Claim(s) 101-104 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Claims 5-18,23-31,35-42,50-57,63-70,80-82,87-89,94-100, and 105-107 are allowed.

In paper no. 4 the examiner had stated that claims 94-104 would be deemed allowable upon correction of an error in syntax. Upon reconsideration the indication of allowability with regard to claims 101-104 is hereby withdrawn in view of the following rejections.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 101 and 102 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Quigley et al, taken as applied in the previous Office action. The patent to Quigley et al discloses a photograph of a fabric (see col. 6, lines 6-9). Claims 101 and 102 are product-by-process claims. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). Also note MPEP 2113 which states that "The lack of physical description in a product-by-process claim makes determination of the patentability of the claim more difficult,

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since in spite of the fact that the claim may recite only process limitations, it is the patentability of the product claimed and not of the recited process steps which must be established. We are therefore of the opinion that when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or section 103 of the statute is eminently fair and acceptable. As a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith." *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972)". In the instant application the photograph of Quigley et al as described in col. 6, lines 6-9 of the reference's disclosure appears to be the same as the product claimed in the product-by-process claims.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 103 and 104 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In claim 103 applicant recites a "method of assessing the texture, pattern, thickness, drape and/or translucency of a fabric comprising the step of viewing a photograph". The step of viewing a photograph is a purely mental step. Process or method patents are authorized by statute, but steps of art or method must be performed upon physical materials and produce some change in their character or condition. Purely mental steps do not form patentable process. *In re Yuan*, 89 USPQ 324 (CCPA 1951). In the instant

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application the mere viewing of a photograph to assess certain physical characteristics of a fabric does not produce any change in the character or condition of the photograph.

Accordingly claims 103 and 104 are directed to non-statutory subject matter.

Claims 103 and 104 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention without undue experimentation. Applicant's specification does not describe how the mere viewing of a photograph would enable one skilled in the art to assess the texture and thickness of a fabric. The texture of a fabric is influenced by a wide variety of factors that are not revealed by a photographic image. These factors include the chemical structure of the material used in constructing the fabric as well as the structural interrelation between the constituent fibers of the fabric. Likewise the thickness cannot be determined from viewing a photograph since any thickness determination depends on the distance of the fabric from the camera lens and optical parameters pertaining to the camera lens. None of these parameters is known by merely viewing the photograph. Further no amount of experimentation on a photograph *per se* can reveal these factors since the factors require knowledge of the fabric and the camera position. This knowledge cannot be determined by any act of viewing the photograph or for that matter by any act performed on the photograph. For these reasons the examiner concludes that applicant's specification does not describe a way that would enable one skilled in the art to which it pertains, or with which it is most

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nearly connected, to make and/or use the invention. The examiner notes that claims 103 and 104 are distinguished from claims 5-18,23-31,35-41,50-57,63-70,80-82,87-89,94-100, and 105-107 since claim 103 recites the term "and/or" in line 2. Thus one skilled in the art must be enabled to assess every one of the fabric qualities recited in claims 103 and 104 (viz. texture, pattern, thickness, drape, and translucency). Claim 5, lines 2-4 recites "so that one or more of each fabric's characteristics of texture, pattern, thickness, drape and translucency, can be reliably understood and compared". Thus one skilled in the art must be enabled to assess only one of the fabric qualities recited in claim 5. Clearly applicant's specification enables one skilled in the art to reliably understand and compare a fabric's pattern since the specification makes clear that a pattern is defined by the shape of a line that is readily evident by the simple act of viewing a photograph. The same comment applies to 6-18,23-31,35-41,50-57,63-70,80-82,87-89,94-100, and 105-107.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter P Nerbun whose telephone number is 703-308-0955. The examiner can normally be reached on M-F (1st Week) M-Th (2d Week).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John J Calvert can be reached on 703-305-1025. The fax phone number for the organization where this application or proceeding is assigned is 703-308-0758.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-

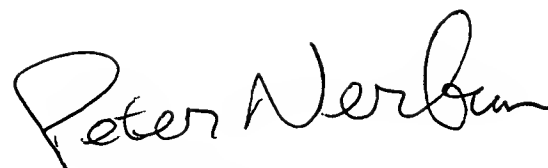
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Peter Nerbun
January 29, 2004


Peter Nerbun
Primary Examiner